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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,109	11/21/2001	Randall A. Boudouris	M112.2-10064	2833

490 7590 11/25/2005

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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,109

Applicant(s)

BOUDOURIS ET AL.

Examiner

Gladys JP Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,13,31-34,36,37,75 and 79-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,13,31-34,36,37,75 and 79-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 4-7, 13, 31, 36, 75, 79, 80-85 are rejected under 35 U.S.C. 103(a) as obvious over Texier (WO 00/01776 with English Equivalent US 6,881,450) in view of the coating art as a whole as exemplified by Korpman et al. (US Patent No. 4,388,349) particularly in view of Tanuma et al. (US Patent No. 4,996,110) and/or Czaplicki et al. (US Patent No. 5,985,435).

Texier discloses a method of forming a magnetic assembly (column 1, lines 24-30) with at least one magnetic layer (a coating of hot melt adhesive binder and magnetic filler) with dimensions and at least one printable substrate layer (sheet material of

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paper; column 3, lines 50-64) with dimensions by providing a magnetic hot melt composition at an elevated temperature (column 2, lines 59-61; column 4, lines 33-46), the composition comprising 75% to 95% of a magnetic material (column 3, lines 24-29) and 5% to 25% of a thermoplastic polymer (column 3, lines 24-29) and directly applying the magnetic hot melt composition at an elevated temperature when it is pliable to a printable substrate layer (column 4, lines 33-46), the printable substrate layer formed of paper, paper products or paste board (column 3, lines 50-64).

As to the limitation that the hot melt composition is applied to the substrate with an extruder and a slot die head, such is considered a conventional coating method in the art. Texier discloses that coating devices of the conventional type including nozzles and rollers are used to coat the hot melt composition to the substrate. Korpman is an example in the art of a conventional coating device which shows it is known in the art to coat hot melt compositions (in particular of the same binders as disclosed by Texier and of compositions with high viscosities; column 1, lines 45-51) to substrates (in particular paper substrates; column 5, line 3) with an extruder and a slot die head (column 2, lines 48-68; column 5, line 1). Additionally, Tanuma discloses an example of how it is known in the art to extrude a magnetic binder compositions with high percentages of magnetic material and bond the composition to a substrate directly (column 5, lines 38-44). Further, Czaplicki discloses another example in the art that shows it is known to extrude magnetic compositions of hot melt adhesives with high percentages of magnetic material. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Texier by

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coating the magnetic hot melt composition on the substrate with a conventional coating apparatus such as an extruder and slot die as is considered well known in the art as exemplified by Korpman for coating substrates such as paper with highly viscous hot melt adhesive compositions particularly since it is known to extrude magnetic compositions with high amounts of fillers as shown by Tanuma (who directly coats to the substrate) and/or Czaplicki.

As to the particular percentages of the magnetic filler and binder in claims 1, 81, 82, 83, 84 and 85, Texier discloses providing the maximum amount of filler as the binder would allow with the example of 75% (column 3, lines 24-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide amounts of filler greater than 75% in the hot melt composition as shown by Texier since Texier discloses providing the maximum amount of filler as the binder would allow and it is known that greater filler percentages are capable with extrusion of the binder material as exemplified by Tanuma and/or Czaplicki, only the expected results would be attained.

As to claim 4, Texier discloses that the product is magnetized (column 3, lines 60-65). As to claim 5, Texier discloses that the magnetic composition is subjected to a magnetic field prior to setting and that a hot melt adhesive is used to control the setting, therefor the field is applied while the composition is at an elevated temperature (column 13-27). As to claim 6, the magnetic composition is at ambient temperature once the product is cooled. Additionally, while not currently claimed, it is noted that Texier discloses it is known to magnetize the composition after setting, thus at ambient

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temperature. As to claim 7, Texier discloses the magnetizing step is accomplished after the applying step (Figure 1). As to claim 13, the temperature of application is only dependent upon the particular binder material used, the claimed range is within the conventional range for the binders disclosed by Texier, and one of ordinary skill in the art would readily recognize applying the composition within conventional ranges particularly since Korpman discloses such temperatures are known (column 4, lines 55-60). As to claims 31 and 36, Texier discloses coating both sides with the composition, which reads on treating the layer with a film and providing an overlamine (column 4, lines 3-6). As to claim 75, Texier discloses forming the assembly into a plurality of magnetic sheet assemblies and layering to form a stacked pad (column 3-6). As to the limitation of binding the sheets together at one end, such is considered conventional in the packaging arts in order to provide a multitude of products conveniently in one pad, only the expected results would be attained. Further, it is considered well known in the packaging arts to package groups items such as novelty items as disclosed by Texier by stacking the items into a pad and binding by either adhesive (on one end for claim 75) or with shrink wrap. Only the expected results would be attained by employing such a well known and conventional packaging practice to the novelty items in Texier for distribution. As to claims 79 and 80, the claimed coating rates are considered within the conventional range, one of ordinary skill in the art would readily recognize applying the composition within conventional coating ranges particularly since Korpman discloses such ranges are known (column 4, lines 59-61).

As to claim 82, all the claim limitations are met by the references as discussed above. It is noted that claim 82 does not require coating with an extruder and slot die head. Texier discloses that the magnetic filler is the maximum that can be accepted by the binder, with 75% as an example. As a result of Applicant's declaration filed September 6, 2005 discussed below, Applicant asserts that the coating apparatus disclosed by Texier is not capable of coating a hot melt composition with a filler amount of 75% or higher. As discussed above, Texier discloses any conventionally known coating devices are used to coat the composition, Korpman discloses an example of how it is well known in the coating art to extrusion coat hot melt compositions with high viscosities to paper substrates, and Tanuma and Czaplicki show examples of how it is known to extrude hot melt binder compositions with high levels of magnetic filler. It would have been obvious to one of ordinary skill in the art at the time of the invention to form a magnetic assembly as shown by Texier by coating a hot melt composition with a magnetic filler amount greater than 75%, 80%, and 85%, for the reasons as set forth above, only the expected results would be attained.

As to claim 84, the references meet all the limitations as set forth above in reference to claims 1 and 82 above.

4. Claims 1, 4-7, 13, 31, 36, 75, 79, 80-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Texier in view of the coating art as a whole as exemplified by Korpman et al. particularly in view of Tanuma et al. and/or Czaplicki et al. as applied to the claims above, and further in view of Marshall et al. (US Patent No. 5,503,891).

As to the claimed percentages of the magnetic composition, Texier suggests providing the maximum percentage of magnetic particles in the binder. It is known in the art to provide at least up to 96% magnetic particles in magnetic compositions in order to provide a stronger magnetic force. For example, Marshall discloses an example of a magnetic assembly where the magnetic composition layer comprises between 60 and 96% magnetic particles (column 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly in Texier with known percentages in the art of magnetic particles in the magnetic composition in order to provide the desired amount of magnetic strength in the finished product as exemplified by Marshall, only the expected results would be attained.

5. Claims 31, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Texier in view of the coating art as a whole as exemplified by Korpman et al. particularly in view of Tanuma et al. and/or Czaplicki et al. and optionally further in view of Marshall et al. as applied to claim 1 above and further in view of Bielek et al. (US Patent No. 6,387,485) and/or Silverschotz et al. (US Patent No. 5,869,148).

It is considered well known in the art of forming magnetic assemblies to provide treatment layers to the printable substrates in order to protect the substrate and to provide release layers to the magnetic assemblies in order to apply the assemblies to additional articles with adhesive. For example, Bielek discloses treating a printable layer of a magnetic assembly with a variety of well known coatings (column 2, lines 21-41). Silverschotz shows another example that it is known in the art to treat the printable

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layer (column 3, lines 1-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Texier by treating the printable substrate layer as is considered well known in the art and further exemplified by Bielek and/or Silverschotz in order to protect the printable layer. As to claim 32, Bielek discloses an example of joining the magnetic layer to a release liner (18) and the step of removing the magnetic assembly from the release liner in order to apply the assembly to additional articles (column 3, lines 27-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown by Texier by applying a release liner as is considered well known in the art and further exemplified by Bielek in order to apply the assembly to additional articles.

6. Claims 31, 32, 33, 34, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Texier in view of the coating art as a whole as exemplified by Korpman et al. particularly in view of Tanuma et al. and/or Czaplicki et al. and optionally further in view of Marshall et al. (US Patent No. 5,503,891) [optionally further in view of Bielek and/or Silverschotz] as applied to claims 1 and 31 above, and further in view of Charley (US Patent No. 6,153,279).

Texier shows a method of forming a magnetic assembly for forming novelty items. It is considered well known in the art to provide magnetic assemblies with a release liner in order to adhere such assemblies to additional articles with an adhesive. It is further considered well known in the art to adhere assemblies with release liners to articles such as magazines, books, food packages, beverage containers, envelopes or

boxes. For example, Charley discloses it is known in the art to form magnetic assemblies with release layers where the assembly is adhered to an article with the use of an adhesive in order to provide such known novelty items to known articles such as boxes. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic assembly of Texier with a release liner and adhesive to adhere to a well known article in order to provide the assembly to consumers as is considered well known in the art and further exemplified by Charley.

As to claims 31, 36 and 37 it is considered well known in the art to provide a perforated overlamine (treat the layer with film) over magnetic assemblies in order to protect the assemblies until the consumer removes the assembly from the article. For example, Charley discloses a magnetic assembly with a perforated overlamine (18; column 3, lines 5-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown in Texier with a perforated overlamine in order to protect the assembly until the consumer removes it from an article as shown by Charley.

Response to Amendment

7. The declarations under 37 CFR 1.132 filed on September 6, 2005 are insufficient to overcome the rejections of the claims.

8. The declaration asserts that the Nordson machine disclosed by Texier for coating the composition can not handle compositions as claimed and that particle levels higher than 75% would not have been expected by a person of ordinary skill in the art to be operable with the disclosed equipment. As discussed above, Texier discloses using

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conventional coating devices. It is well known to coat highly viscous hot melt adhesives to paper substrates with an extruder and slot die as exemplified by Korpman. Texier discloses that the maximum filler is used in the binder. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide filler amounts greater than 75% in the composition as disclosed by Texier in order to provide the maximum amount as is capable with extruders as exemplified by Tanuma and/or Czaplicki and/or Marshall.

Response to Arguments

9. Applicant's arguments filed September 5, 2005 have been fully considered but they are not persuasive.

Applicant argues that the Texier reference does not suggest the claimed extruder coating device and that the device in Texier is not capable of coating the claimed compositions as evidenced by the Declaration. Such arguments are obviated by the rejection above.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys JP Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys JP Corcoran
Primary Examiner
Art Unit 1733

GJPC